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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,458	04/03/2001	Venkata Katikaneni	F-113	8314

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,458

Applicant(s)

KATIKANENI ET AL.

Examiner

Edward R. Cosimano

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-37 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>July 21, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.
3. The proposed drawing correction filed April 03, 2001 has been approved, however, these changes have not been incorporated into the drawings filed April 03, 2001.
4. In regard to the preliminary amendment filed April, 30, 2001:
 - A) so as to be consistent with the remainder of the disclosure and figs. 4C and 5, in the first insert to page 13 filed April 03, 2001, "When the structure of the postage printing ... an ad slogan 500 are printed ... control system algorithm 500 ... shown. The algorithm 50 may ... ad slogan 50. This ... make a section using keypad 382.":
 - (1) at line 3 of this insert, "ad slogan 500" has been changed to -ad slogan 50--; and
 - (2) at line 6 of this insert, "algorithm 50" has been changed to -algorithm 500--.
 - B) it is noted that the at pages 5-6 of the amendment filed April 03, 2001, applicant has submitted an amendment to page 14, however:
 - (1) the indicated paragraph does not appear at page 14 of the original specification; and
 - (2) appears to be a duplicate of the amendment to page 13 on pages 4-5 of the amendment filed April 03, 2001;therefore the amendment to page 14 has not been entered.
 - C) it is noted that the at pages 6-7 of the amendment filed April 03, 2001, applicant has submitted an amendment to page 15, however, the indicated paragraph

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does not appear at page 15 of the original specification. Since the indicated paragraph appears at pages 14-15 of the original specification, this amended paragraph has been entered at page 14.

5. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120/119(e) as follows:

A) An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR § 1.78(a)(2) and (a)(5)).

5.1 If applicant desires priority under 35 U.S.C. § 120/119(e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

5.2 If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR § 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. § 119(e), § 120, § 121 and § 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. § 119(e), § 120, § 121 and § 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR § 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

6. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1 as required above,
with the current status of each of the referenced applications, e.g., --now abandoned--,
or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

7. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

8. Claims 13-17, 19, 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8.1 Claims 13-17, 19, 20, 25-29, 31 & 32 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) in regard to claims 13-17, 19, 20 recite a postage printing system, however these claims fail to actually print a postage indicia, since:

(1) claim 13 recites a wall, transport device, a printer and a control system, where the printer is capable of printing an indicia but as recited in the claim does not print a postage indicia and the control system merely determines whether one or two print passes are required;

(2) claim 14 merely recites how the printer is controlled;

(3) claim 15 merely recites providing information to the user about the orientation of the envelope;

(4) claims 16, 17, 19 & 20 merely recite detecting the orientation of the envelope and controlling how the data is to be printed

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B) in regard to claims 25-29, 31 & 32 recite a postage printing system, however these claims fail to actually print a postage indicia, since:

(1) claim 25 recites a transport device, defining possible print positions, obtaining a indication of the location of message/slogan/ad; and determining whether one or two print passes are required;

(2) claim 26 merely recites how the printer is controlled;

(3) claim 27 merely recites providing information to the user about the orientation of the envelope;

(4) claims 28, 29, 31 & 32 merely recite detecting the orientation of the envelope and controlling how the data is to be printed

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

8.2 For the above reasons, applicant has failed to particularly point out what is regarded as the invention.

9. Claims 13-37 are rejected under the judicially created doctrine of double patenting over claims 1-8 of U. S. Patent No. 6,356,883 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

9.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) a transport path through a postage printing system

B) a printer for printing postage indicia and messages/slogans/ads;

C) a control system for obtaining a location of the message/slogan/ad and determining if the both the indicia and the message/slogan/ad can be printed in one or two passes of the envelope through the postage printing system.

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9.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

9.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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10.1 Claims 13, 14, 25, 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al (5,168,804) in view of either Hunter (5,493,106) or Kara (5,717,597) as suggested by Storace et al (5,831,554) and further in view of Cannon et al (5,748,484).

10.1.1 In regard to claims 13 & 25, Lee et al ('804) discloses a postage metering system in which a transportation system moves an item of mail by a postage printer. Where the postage printer will print a postage indicia and may print a personalized message or advertisement. Although the postage printing system of Lee et al ('804) teaches that the user selects a personalized message or advertisement that is automatically positioned, the system of Lee et al ('804) uses print dies that do not easily allow for the user to select variable message or advertisement to be printed with the postage indicia.

10.1.2 In the environment of postage metering systems, either Hunter ('106) or Kara ('597) disclose a postage metering system. In the postage metering systems of either Hunter ('106) or Kara ('597) it is desirable to allow the user to personalizing the item of mail, for example a card, by selecting the message or advertisement. The selected message or advertisement is then printed with the postage indicia by the postage printers of either Hunter ('106) or Kara ('597).

10.1.3 It is noted that the printing system of Lee et al ('804) will not support the wide selection of personalized messages or advertisements suggested by the systems of either Hunter ('106) or Kara ('597). However in the environment of postage metering systems, Storace et al ('554) discloses that it is desirable to modify the postage printer in the postage metering system of Lee et al ('804) to include a digital printer such as a ink jet printer or thermal printer. Such a modification permits the user to select the personalized message or advertisement that is to be printed with the postage indicia as taught by either Hunter ('106) or Kara ('597).

10.1.4 Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the postage printer of Lee et al ('804) could be replaced by a digital printer as taught by Storace et al ('554) so that the user may easily select the personalized message or advertisement that is automatically positioned so as to be printed with the postage indicia as taught by either Hunter ('106) or Kara ('597).

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10.1.5 However, Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) does not disclose a control system that:

A) receives an indication from the user of the placement of the message/advertisement; and

B) determines if one or two printing passes are required to print the combination of a postage indicia and message/advertisement at the desired location.

10.1.6 In the environment of personalizing items of mail, Cannon et al ('484) discloses a system in which the user is permitted to select the location on an item at which personalized text is to be placed. In the system of Cannon et al ('484) as disclosed at column 11, line 46, to column 12, line 31, the user selects the location of images and/or text that is to appear on the item of mail. Based on the user's selections, the item of mail is printed. Such a system permits the user more control over the appearance of the item of mail.

10.1.7 Since the function of either Hunter ('106) or Kara ('597) or Cannon et al ('484) is to personalize item of mail, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) could be further modified to permit the user to select the location on the item of mail at which the message or advertisement is to be printed as taught by Cannon et al ('484).

10.1.8 In regard to the need to use one or two printing passes, it is noted that the physical components of the postage metering and printing system as well as the size of the message or advertisement to be printed govern how many printing passes are required to print the postage indicia and personalized message or advertisement. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) could be further modified to indicate to the user that one or more printing passes are required in order to print the postage indicia and personalized message or advertisement.

10.1.9 In regard to the order in which the postage indicia and personalized message or advertisement are printed as recited in claims 14 & 26, since the result of the postage metering

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systems of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) is to produce an item of mail with a postage indicia and a personalized message or advertisement, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) could print the indicia or message in any sequence so long as both the indicia and message are placed in the item of mail.

11. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Lee et al (5,168,804) discloses a postage metering system in which an user selects a personalized message or advertisement and the location that the message or advertisement is to be placed on an item of mail, where the prior art required the user to manually position the personalized message or advertisement, the current system would automatically position the personalized message or advertisement.

(2) either Hunter (5,493,106) or Kara (5,717,597) or Storace et al (5,831,554) or Cannon et al (5,748,484) disclose a postage metering system in which an user selects a personalized message or advertisement and the location that the message or advertisement is to be placed on an item of mail.

B) however, in regard to claims 15, 21, 27 & 34, the prior art does not teach or suggest indicating to the user the anticipated orientation of the item of mail during the subsequent printing passes. Claims 16-18, 22-24, 28-30 & 35-37 are allowable for the same reason.

C) however, in regard to claims 16, 19, 22, 28, 31 & 35 the prior art does not teach or suggest using a scanner to detect distinguishing characteristics of the item of mail. Claims 17, 18, 20, 23, 24, 29, 30, 32, 33, 36 & 37 are allowable for the same reason.

D) however, in regard to claims 18, 24, 29, 33 & 37, the prior art does not teach or suggest printing the message or advertisement in a particular orientation based on the selected location to print the message or advertisement.

12. The examiner has cited prior art of interest, for example:

A) Meerssman (FR 2720180) which discloses an advertising flap that is detachable from an envelope.

B) Kim et al (5,509,109) which disclose a postage metering system that prints a combination of a postage indicia and a message/advertisement that, with authorization from a remote center, has been downloaded to the meter's memory or stored in an external slogan box attached to the meter.

C) either Dougherty or Wenzel (EP 0807916 A1) or Scisco which disclose a postage metering system that prints a combination of a postage indicia and a message/advertisement.

D) Heiden et al (6,141,654) which disclose a postage metering system that prints a combination of a postage indicia and an advertiser selected message or advertisement or inscription in a location specified by the advertiser.

12.1 The examiner has considered the prior art cited in the parent application and in the disclosure at pages 2-4 & 7, that is U.S. Pat. Nos. 4,725,718; 4,831,554; 4,978,114; 5,024,153; 5,168,804; 5,454,038 and 5,509,109.

13. Claims 15-20 & 27-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

15.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

15.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

15.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

06/10/04

A handwritten signature in cursive script that reads "Edward Cosimano".

Edward R. Cosimano
Primary Examiner A.U. 3629